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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,167	06/26/2001	Andy L. Ruse	219.40066X00	1366
23838	7590	09/21/2007		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER JOO, JOSHUA	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/891,167	Applicant(s) RUSE ET AL.	
	Examiner Joshua Joo	Art Unit 2154	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Detailed Action***

1. Claims 1-18 are presented for examination.

**Response to Arguments**

2. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 7-12, Applicant is seeking to patent a system comprising of modules (monitoring module, trend analysis module, forwarding module), wherein Applicant has provided evidence in the specification that the modules are intended to be software modules (See page 5, paragraph 14). Software does not meet one of the four categories of invention and is not statutory. Specifically, software is not a series of steps or acts and thus is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a composition of matter.

Regarding claims 13-18, Applicant is seeking to patent a computer program. The claimed invention of a computer program does not meet one of the four categories of invention and is not statutory. Specifically, computer program is not a series of steps or acts and thus is not a process. Computer program is not a physical article or object and as such is not a machine or manufacture. Computer program is not a combination of substances and therefore not a composition of matter.

**Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) Regarding claim 1, "the location" lacks sufficient antecedent basis.
- ii) Regarding claim 7, "the location" and "the user" lack sufficient antecedent basis.
- iii) Regarding claim 13, "the location" lacks sufficient antecedent basis.

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 7-11, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al, US Publication #2007/0011314 (Horvitz hereinafter), in view of Foladare et al. US Patent #6,311,210 (Foladare hereinafter).

8. As per claims 1 and 13, Horvitz teaches substantially the invention as claimed including a method for forwarding messages, comprising:

monitoring locations of "activities" along with the time of day and day of week (Paragraphs 0026; 0028; 0048. Discern user location. Observe user location and activities time of day and day of week.);

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storing "activities" along the associated time of day and day of week in a database (Paragraph 0026; 0028. Store user context information regarding location and activities per time of day and day of the week.);

performing a statistical trend analysis on a user basis to determine a probability of contacting the user for a given time of day and day of week at a given location (Paragraph 0027. Infer parameters that indicate likelihood user is in different locations. Paragraph 0028. Use statistical model to determine likelihood user is in a state. Paragraph 0053. Performs analysis on information provided by sinks including user's location. Paragraph 0064. Probabilistic inference/profile.);

storing a trend analysis table the result of the statistical trend analysis performed (Paragraphs 0028; 0039-0010; 0063. User context profile used to make decisions. Store priori about user location and user activity. Paragraph 0063. User context profile store captures information such as deterministic or probabilistic profile.); and

transferring incoming messages to the location in the trend analysis with the highest probability of contacting the user (Paragraph 0040. Determine best device for relay notification. Paragraph 0063. Best guess about user context information.).

9. Horvitz teaches of monitoring locations of activities but did not specifically teach the activities to include responses to incoming messages.

Foladare teaches of sending messages to devices and monitoring access of incoming messages by a device (col. 3, lines 56-60; col. 5, line 66-col. 6, line 7. Examiner considers accessing an incoming message as a user response to the message.).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Horvitz and Foladare for the monitoring of activities as taught by Horvitz to include monitoring response to messages as taught by Foladare. The motivation for the suggested

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combination is that Foladare's teachings of monitoring access of incoming messages would provide a specific activity for determining and monitoring the user's location and activity. Foladare's teachings would also provide message/notification sending based on the type of user device (col. 3, lines 45-53).

11. As per claim 7, Horvitz teaches substantially the invention as claimed including a system for forwarding messages, comprising:

a monitoring module to monitor "activities" by users and store the location of the response with a time stamp in a database (Paragraphs 0026; 0028; 0048. Discern user location. Paragraph 0026; 0028. Store user context information regarding location and activities per time of day and day of the week. Paragraph 0081. Users);

a trend analysis module to perform a statistical probability analysis on the location and time stamp data in the database and determine the probability of contacting the user at each of a plurality of locations for a given time of day (Paragraph 0027. Infer parameters that indicate likelihood user is in different locations. Paragraph 0028. Use statistical model to determine likelihood user is in a state. Paragraph 0053. Performs analysis on information provided by sinks including user's location. Paragraph 0064. Probabilistic inference/profile.) and storing the probability of contacting the user at each of a plurality of locations in a trend analysis table (Paragraphs 0028; 0039-0040; 0063. User context profile store used to make decisions. Store priori about user location and user activity. Paragraph 0063. User context profile store captures information such as deterministic or probabilistic profile.); and

a forwarding module to receive an incoming message and forward the incoming message to a location with the highest probability of contacting the user as designated in the trend analysis table (Paragraph 0040. Determine best device for relay notification. Paragraph 0063. Best guess about user context information.).

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12. Horvitz teaches of monitoring locations of activities but did not specifically teach the activities to include responses to messages received.

Foladare teaches of monitoring access of incoming messages by a device (col. 3, lines 56-60; col. 5, line 66-col. 6, line 7. Examiner considers accessing an incoming message as a user response to the message.).

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Horvitz and Foladare for the monitoring of activities as taught by Horvitz to include monitoring response to messages as taught by Foladare. The motivation for the suggested combination is that Foladare's teachings of monitoring access of incoming messages would provide a specific activity for determining and monitoring the user's location and activity. Foladare's teachings would also provide message/notification sending based on the type of user device (col. 3, lines 45-53).

14. As per claims 2, 8 and 14, Horvitz teaches the invention of claims 1, 7 and 13, wherein said trend analysis table comprises a user identification, a plurality of times a day and days of week with locations of contact and probabilities of successful contact associated with each locations (Paragraphs 0026; 0065. User profile can be of locations and activities per the time of day and day of the week. Paragraph 0027. Infer likelihood user is in different locations. Paragraph 0040. Determine best device for relay notification. Paragraph 0063. Probabilistic profile).

15. As per claims 3, 9, and 15, Horvitz teaches the invention of claims 2, 8, and 14 wherein said trend analysis table further comprises a user override location that indicates probabilities of successful contact for each location are to be ignored and only the override location is to be used for contact (Paragraph 0063. User context store can be edited and modified by the user. Paragraphs 0079-0080. User context information determines which device to send notification based on parameters of the user.).

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16. As per claims 4, 10, and 16, Horvitz and Foladare taught the invention defined in claims 3, 9, and 15. Horvitz further teaches the invention of wherein the incoming messages and responses are from PSTN telephone, cellular telephone, pager, fax, voice mail, e-mail or other voice or digital communication format (Paragraph 0030. Email. Paragraphs 0021; 0038. Cell phone).

17. As per claim 5, 11, and 17, Horvitz and Foladare taught the invention defined in claims 4, 10, and 16. Horvitz further teaches the invention where the invention further comprises of checking the user override location in the trend analysis table and transmitting the incoming message to the user override location when set (Paragraph 0063. User context store can be edited and modified by the user. Paragraphs 0079-0080. User context information determines which device to send notification based on parameters of the user.).

18. Claims 6, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz and Foladare, in view of Singh, US Patent #6,405,035 (Singh hereinafter).

19. As per claims 6, 12, and 18, Horvitz teaches the invention of claims 4, 10, and 16 comprising: contacting the user at the location with the highest probability of successful contact associated with the location. (Paragraph 0040. Determine best device for relay notification. Paragraph 0063. Best guess about user context information.). Horvitz does not specifically teach of contacting the user at the location with second highest probability of success when unable to contact the user at the location with the highest probability of success.

Singh teaches a similar system comprising of contacting a second ranked device when unable to contact the user at a device with the highest probability of success (col. 6, lines 8-14. If the subscriber doesn't access the message of the first device, the message is send to the next ranked device.).



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20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the suggested system of Horvitz and Foladare with the teachings of Singh to contact a second ranked device when unable to contact the user at a device with the highest probability of success. The motivation for the suggested combination is that Singh's teachings would increase the possibility that the user receives a message by forwarding the message to more than one device, and ensure that the client receives the message (col. 6, lines 14-17).

### **Conclusion**

21. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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September 10, 2007

JJ

A handwritten signature in black ink, appearing to be 'Nathan Flynn', written over a printed name and title.

**NATHAN FLYNN**  
**SUPERVISORY PATENT EXAMINER**